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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,380	01/27/1999	MATITYAHU FRIDKIN	FRIDKIN=1	3626

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BROWDY & NEIMARK  
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SUITE 300  
WASHINGTON, DC 20001

EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/117,380

Applicant(s)

FRIDKIN ET AL.

Examiner

Richard G. Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-9, 12, 13, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9, 12, 13, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's amendment of claim 25 and the addition of new claim 26, in the paper of 4/14/2004, are acknowledged.

Claims 2-9, 12, 13, 25 and 26 are still at issue and are present for examination.

Applicants' arguments filed on 4/14/2004, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-9, 12, 13, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A similar rejection based on applicants previous amendment of claim 25 was stated in the previous office action. Applicants have again amended claim 25, and traverse the rejection as it applies to the currently amended claims.

Applicants newly amended claim 25 (claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13 and 26 dependent from) is rejected as containing new matter because the recitation "...with the

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proviso that the residue at 89 is not Leu, the proviso that the residue at 90 is not Glu, the proviso that the residue at 91 is not Ala, the proviso that the residue at 92 is not Ile, the proviso that the residue at 94 is not Ala or Val or Phe, the proviso that the residue at 95 is not Ser, the proviso that the residue at 96 is not Ile all at the same time;...", is not supported by the original disclosure.

Applicants continue to traverse the rejection as in the previous response, on the basis that applicants situation is "exactly the same as in" *In re Johnson* and that the examiner's understanding of *In re Johnson* appears to be flawed. As previously submitted by applicants, the present specification discloses many species and that as in *In re Johnson*, applicants have support for the exclusion of these species. Applicant's complete argument has been thoroughly re-considered, however, continues to be found nonpersuasive for the reasons previously stated and repeated below.

While Applicants submission that a claim meets the description requirement on the basis that "If a genus is disclosed in the specification, including a number of specific species, then that genus excluding one of the specified species also satisfies the written description requirement" is acknowledged and found persuasive, the claims remain rejected on the basis that applicants have not specifically disclosed the excluded genus/species.

As previously stated, applicants argument as it applies to Claim A and each of the additional exhibit claims B-G is not found persuasive. Applicants are again reminded that applicants original claim and disclosure was directed to a genus of molecules comprising a great number of species. While applicants disclose the genus,

applicants do not disclose the great majority of the encompassed species. If applicants were to propose an amendment to the claims to a specific species encompassed within the disclosed genus, a species of which there was not prior support in the disclosure for, a rejection would be made stating that while applicants had support for the claimed genus, applicants disclosure did not support the newly proposed species. Analogously applicants do not have support in the original disclosure for the originally supported genus minus a specific species of which there is no support for. In effect applicants do not have support for this newly proposed genus.

Applicants reference to *In re Johnson*, 194 USPQ 187, 196 (1977) in support of their position is again acknowledged, however, applicants argument is still not found persuasive.

In *In re Johnson*, 194 USPQ 187, 196 (1977), "Fifty specific choices are mentioned for the E precursor compound, a broad class is identified as embracing suitable choices for the E' precursor compound, and twenty-six "examples" are disclosed which detail fifteen species of polyarylene polyethers. Only fourteen of those species and twenty-three of the "examples" are within the scope of the claims now on appeal. Two of the many choices for E and E' precursor compounds are deleted from the protection sought, because appellant is claiming less than the full scope of his disclosure. Herein lies the distinction between *In re Johnson*, 194 USPQ 187, 196 (1977) and the current application, While in the Johnson case applicants were deleting two of the many choices which were disclosed, in the present case applicants continue to attempt to delete a choice which was not originally disclosed.

Newly added claim 26 is further rejected under this statute, because the claimed genus "wherein the peptide of (C) is no longer than 30 residues" is not supported by the specification at the time of filing and thus considered new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 2, 3, 9 and 25 under 35 U.S.C. 102(b) as being anticipated by Insley et al. (European Patent Application 0 155 188) is hereby withdrawn based on applicants amendment.

Claims 2, 3 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lepiniec et al. (FEBS Letters Vol 364, pp 103-108, 1995).

Lepiniec et al. teach the characterization of an *Arabidopsis thaliana* cDNA homologue to the human poly(ADP-ribose) polymerase and the encoded protein. The taught protein comprises the amino acid sequence "...Y<sub>360</sub>TVIPHDF<sub>367</sub>..." which meets all of the structural limitations of the claimed genus of isolated polypeptides and thus anticipates claims 2, 3 and 25.

***Claim Rejections - 35 USC § 103***

The rejection of claims 9, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Insley et al. (European Patent Application 0 155 188) is hereby withdrawn based on applicants amendment.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

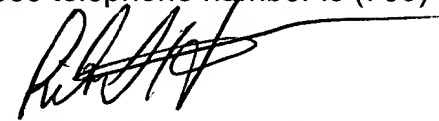
***Remarks***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit 1652

rg  
11/29/2005